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EXAMINER

DO,P  
ART UNIT PAPER NUMBER

1641  
DATE MAILED:

7  
04/10/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/633,295

Applicant(s)

Alfons Nichtl

Examiner

P nsee T. Do

Group Art Unit

1641



☒ Responsive to communication(s) filed on Jan 22, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 17-21 and 23 is/are pending in the applicat

Of the above, claim(s) 23 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 17-21 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 17-21 and 23 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of group I, claims 17-21, in Paper No. 6 is acknowledged.
2. Claims 17-21 are pending. Claim 22 was canceled without prejudice.

### ***Claim Rejections - 35 U.S.C. § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For all independent claims, in line 1 please add --A-- in front of "Method".

For all dependent claims, in line 1 please add --The-- in front of "Method".

Claims 17-21 fail to recite conventional claim language, i.e. comprising, consisting of, having, etc.

Claims 17-21 fail to recite a *stepwise* method.

Claim 17 is confusing in reciting "or/and to" in line 5 and "before" in line 6. Please change "this" in line 7 to --the-- or --said-- for proper antecedent basis.

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Claim 18 is unclear as what the "critical micelle concentration" is and what is the non-exceeded amount? Also, the recitation of "the critical micelle concentration" lacks antecedent support.

Claim 19 is unclear according to the recitation of "the final concentration". What is the beginning concentration? The concentration of the mixture, the conjugate and the detergent, or the concentration of the detergent only ?

Claim 20 is confusing because it recites "after completion of the conjugation". The preceding step of the method has not recited a conjugating step.

***Claim Rejections - 35 U.S.C. § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by Liberti et al. (US 5,597,531).

Liberti teaches a coating process comprising coating a wide range of materials (including dextran, proteins, synthetic polypeptides, polymers, detergents, polyethylene glycol and

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combinations thereof) onto colloidal magnetically responsive particles to obtain stable microagglomerants. The process comprises the following steps:

- (a) forming a liquid mixture of a particulate magnetic starting material and a coating material;
- (b) treating the mixture to subdivide the particles of the magnetic starting material;
- (c) permitting the coating material to form a coating on the subdivided particles of the magnetic starting material to form stable, resuspendable coated particles;
- (d) recovering the resuspended coated magnetic particles from the liquid mixture.

(See col. 4, lines 45-52; claim 1).

***Claim Rejections - 35 U.S.C. § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liberti et al. (US 5,597,531).

Liberti has been discussed above.

Liberti differs from the invention in failing to teach adding the detergent in an amount at which the critical micelle concentration is not exceeded and at which the final concentration is

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0.001 to 1 mM. Liberti also fails to teach an additional stabilizer such as an inert protein or/and polyethylene glycol.

However, the optimum concentration of detergent to stabilize the colloidal particles can be determined by routine experimentation and thus would have been obvious to one of ordinary skill in the art. Regarding the additional stabilizer, since it is well known in the art and Liberti also teaches that polyethylene glycol binds strongly to the surface of the particles, it would have been obvious to one of ordinary skill in the art to use polyethylene as an additional stabilizer besides the combination of detergents and protein to further stabilize the colloidal particles to the advantage of long-term storage and minimum or no aggregation.

### *Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is (703) 308-4398. The examiner can normally be reached on Mon-Fri. from 7 a.m. to 3 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

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Pensee T. Do  
Patent Examiner  
April 9, 2001

*Christopher L. Chin*  
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PRIMARY EXAMINER  
GROUP 1800/1641